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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,418	09/30/2003	Nathanael F. Ehrich	RSW920030221US1	6181

7590 11/01/2005  
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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/675,418

Applicant(s)

EHRICH ET AL.

Examiner

CESAR B. PAULA

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/30/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is responsive to the application, and IDS filed on 9/30/2003.

**This action is made Non-Final.**

2. Claims 1-28 are pending in the case. Claims 1, 22, and 26-27 are independent claims.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 9/30/2003 has been entered, and considered by the Examiner.

***Drawings***

4. The drawings filed on 9/30/2003 have been accepted by the Examiner.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, and 22 recite a method which could be performed using a combination of mental and/or pen an paper steps, not on a computer device.

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### ***Double Patenting***

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claim 1-8, 26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 18, 18, 18, 18, 18, 18, 18, 7, 18 respectively of copending Application No. 10/674,769. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 22, and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of copending Application No. 10/674,769 (hereinafter 769). Although the conflicting claims are not identical, they are not patentably distinct from each other because although claim 18 of 769 does not explicitly teach *programmatically generating a syntax specification*, Kanevsky discloses

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selectively displaying certain group of component(s) of the HTML web pages generated using URL/CGI instructions, such as icons, text, images, etc, -- *programmatically generating a syntax specification which includes a plurality of alternative selectable views for at least one component* -- based upon the interpretation of the URL instructions, and the device's characteristics (col. 11, lines 1-62, col.8, lines 1-2, fig.10-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine 769, and Kanevsky, because Kanevsky teaches above web pages which are adaptively generated to conform with a device characteristic, thus allowing a user to comfortably, and effectively view the web page.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanevsky (Pat.# 6,300,947 B1, 10/9/2001).

Regarding independent claim 1, Kanevsky discloses interpreting URL instructions containing information regarding the content of web pages to determine whether or not the web pages meet certain criteria, such as a device characteristics-- *evaluating one or more factors to yield an evaluation result*-- (col. 7, lines 57-col.8, line 42).

Moreover, Kanevsky discloses selectively displaying certain group of component(s) of the web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics-- *using the evaluation result to select from among a plurality of alternative selectable views of a particular component, a view to be rendered* -- (col. 11, lines 1-62, col.2. lines 1-44, fig.10-15).

Regarding claim 2, which depends on claim 1, Kanevsky discloses selectively displaying certain group of component(s) of the web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics-- *rendering the selected view* -- (col. 11, lines 1-62, fig.10-15).

Regarding claim 3, which depends on claim 1, Kanevsky discloses selectively displaying certain group of component(s) of the web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics-- *the view to be rendered comprises a portion of content to be rendered* -- (col. 11, lines 1-62, fig.10-15).

Regarding claim 4, which depends on claim 1, Kanevsky discloses selectively displaying certain group of component(s) of the web pages, such as icons, text, images, etc, based upon the

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interpretation of the URL instructions, and the device's characteristics-- *the view to be rendered comprises a portion of a Web page to be rendered* -- (col. 11, lines 1-62, fig.10-15).

Regarding claim 5, which depends on claim 1, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics-- *the plurality of alternative selectable views are specified in a markup language document* -- (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding claim 6, which depends on claim 5, Kanevsky discloses selectively displaying certain group of component(s) of the web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics—*a web page that is to be rendered* -- (col. 11, lines 1-62, fig.10-15).

Regarding claim 7, which depends on claim 1, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics-- *the plurality of alternative selectable views are specified using a scripting language syntax* -- (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding claim 8, which depends on claim 5, Kanevsky discloses selectively displaying certain group of component(s) of the web pages, such as icons, text, images, etc, split up in a

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hierarchical fashion, based upon the interpretation of the URL instructions, and the device's characteristics (col. 11, lines 1-62, col.2, lines 1-44, fig.10-15).

Regarding claim 9, which depends on claim 5, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions—*logic--*, and the device's characteristics (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding claim 10, which depends on claim 7, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions—*logic--*, and the device's characteristics (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding claim 11, which depends on claim 5, Kanevsky discloses sending the web page as adapted from a server to a client for display (col. 7, lines 41-67).

Regarding claim 12, which depends on claim 11, Kanevsky discloses sending the web page, as adapted, from/at a server to a client for display (col. 7, lines 19-67).

Regarding claim 13, which depends on claim 11, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images,



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etc, based upon the interpretation of the URL instructions, and the device's characteristics—*dynamic factor* (col.8, lines 24-67, fig.10-15).

Regarding claim 14, which depends on claim 11, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions received over the Internet—*network--*, and the device's characteristics—*dynamic factor* (col.8, lines 24-67, col.4, lines 58-67, col.13, lines 31-67, fig.10-15).

Regarding claim 15, which depends on claim 11, Kanevsky discloses selectively displaying certain group of component(s)-- *alternative selectable views for each components--* contained within the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions and the device's characteristics (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding claim 16, which depends on claim 15, Kanevsky discloses selectively displaying certain group of component(s) contained within the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions—*using step is performed for one or more other components--* and the device's characteristics (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

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Regarding claim 17, which depends on claim 15, Kanevsky discloses selectively displaying certain group of component(s) contained within the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions and the device's characteristics (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding claim 18, which depends on claim 16, Kanevsky discloses selectively displaying certain group of component(s) contained within the HTML web pages, such as icons, text, images, etc, into various pages based upon the interpretation of the URL instructions and the device's characteristics, such as screen size (col. 11, lines 1-62, col.8, lines 16-34, col.11, lines 14-67, fig.10-15).

Regarding claim 19, which depends on claim 16, Kanevsky discloses splitting up a web page into hierarchically linked pages based upon priority, and the interpretation of the URL instructions and the device's characteristics, such as screen size (col. 11, lines 1-62, col.8, lines 16-34, col.2, lines 2-19, fig.10-15).

Regarding claim 20, which depends on claim 5, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions—*reference to logic* --, and the device's characteristics (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding claim 21, which depends on claim 7, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions—*reference to logic --*, and the device's characteristics (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding independent claim 22, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages generated using URL/CGI instructions, such as icons, text, images, etc, -- *programmatically generating a syntax specification which includes a plurality of alternative selectable views for at least one component --* based upon the interpretation of the URL instructions, and the device's characteristics (col. 11, lines 1-62, col.8, lines 1-2, fig.10-15).

Moreover, Kanevsky discloses selectively displaying certain group of component(s) of the web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics-- *such that a run time evaluation of the syntax specification will evaluate one or more currently-applicable conditions and use a result of the evaluation to programmatically select a particular one of the alternative selectable views for each of the at least one components. --* (col. 11, lines 1-62, col.2. lines 1-44, fig.10-15).

Regarding claim 23, which depends on claim 22, Kanevsky discloses selectively displaying certain group of component(s) of the web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics-- *selecting the plurality of alternative selectable views for at least one of the components based on one or*

*more characteristics of a target receiver of the syntax specification -- (col. 11, lines 1-62, col.2. lines 1-44, fig.10-15).*

Regarding claim 24, which depends on claim 22, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions, and the device's characteristics (col. 11, lines 1-62, col.8, lines 16-34, fig.10-15).

Regarding claim 25, which depends on claim 22, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages, such as icons, text, images, etc, based upon the interpretation of the URL instructions received over the Internet—*characteristic of client system--*, and the device's characteristics—*dynamic factor* (col.8, lines 24-67, col.4, lines 58-67, col.13, lines 31-67, fig.10-15).

Regarding independent claim 26, Kanevsky discloses selectively displaying certain group of component(s) of the HTML web pages generated using URL/CGI instructions, such as icons, text, images, etc, --*means for evaluating one or more factors to yield an evaluation result; means for using the evaluation result to select, from among a plurality of alternative selectable views of a particular component, a view to be rendered; means for rendering the selected view is a portion of a Web page --* based upon the interpretation of the URL instructions, and the device's characteristics (col. 11, lines 1-62, col.2. lines 1-44, col.8, lines 1-2, fig.10-15).

Claims 27-28 are directed towards a computer program product on a computer-readable medium for storing the steps found in claims 22, and 24 respectively, and therefore are similarly rejected.

### *Conclusion*

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hill et al. (Pat. # 6,023,714).

II. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

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**CESAR PAULA**  
**PRIMARY EXAMINER**

10/31/05